

REMARKS

Claims 1-31 are currently pending in the present application, with claims 1, 3, and 10-11 being written in independent form. Non-elected claims 1-2, 5-19, and 24-31 remain withdrawn from consideration. No amendments are currently being made to the claims.

Information Disclosure Statements

Applicants note that the supplemental information disclosure statement of December 7, 2006 was resubmitted November 2, 2009.¹ Accordingly, Applicants respectfully request the Examiner to indicate in the next action that the resubmitted information disclosure statement of December 7, 2006 has been considered.

Nonstatutory Double Patenting

Claims 3-4 and 22-23 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-11 of copending and commonly-assigned U.S. Application No. 11/540,478. Because the present claims and the claims for U.S. Application No. 11/540,478 are still undergoing prosecution (and, thus, subject to change so as to render this rejection moot), Applicants respectfully request the Examiner to hold this rejection in abeyance.

Claims 3-4 and 21-23 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-

¹ Because the supplemental information disclosure statement of December 7, 2006 was resubmitted November 2, 2009, it would not have been on record at the time of mailing the current Office Action of October 28, 2009. In any event, the USPTO patent

5 of copending and commonly-assigned U.S. Application No. 10/593,706. Because the present claims and the claims for U.S. Application No. 10/593,706 are still undergoing prosecution (and, thus, subject to change so as to render this rejection moot), Applicants respectfully request the Examiner to hold this rejection in abeyance.

Claims 3-4 and 22-23 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-12 and 17 of copending and commonly-assigned U.S. Application No. 10/577,355. Because the present claims and the claims for U.S. Application No. 10/577,355 are still undergoing prosecution (and, thus, subject to change so as to render this rejection moot), Applicants respectfully request the Examiner to hold this rejection in abeyance.

Claim Rejections under 35 U.S.C. § 103 (Adachi)

Claims 3-4 and 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US 2005/0049379 (Adachi). Applicants respectfully traverse this rejection for the reasons below.

Subject matter developed by another person, which qualifies as prior art *only* under one or more of subsections (e), (f), and (g) of 35 U.S.C. § 102, shall not preclude patentability under 35 U.S.C. § 103(a) where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.²

application information retrieval (PAIR) system indicates that the November 2, 2009 resubmission is now on record.

² 35 U.S.C. § 103(c).

Adachi currently stands as a reference only under 35 U.S.C. § 102(e).³ Furthermore, the subject matter of Adachi and Applicants' claimed invention was owned by the same person or subject to an obligation of assignment to the same person at the time Applicants' claimed invention was made.⁴ Consequently, Adachi may be disqualified under 35 U.S.C. § 103(c). Accordingly, the present rejection cannot be sustained.

Claim Rejections under 35 U.S.C. § 103 (Nakashima)

Claims 3-4 and 20-23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 02/100451 (Nakashima). Applicants respectfully traverse this rejection for the reasons below.

Applicants maintain the position articulated on June 26, 2009 but would like to address various comments made by the Examiner in the current Office Action of October 28, 2009. However, it should be understood that Applicants do not concede as to the propriety of any of the Examiner's comments that are not specifically addressed herein.

As previously articulated on June 26, 2009, Nakashima fails to disclose or suggest, *inter alia*, a water absorbent wherein the "CRCs for 0.9 wt % saline is not less than 15 g/g but **less than 29 g/g**," as recited by independent claim 3. Rather, Nakashima explicitly teaches a water-absorbing agent wherein the CRC for 0.90

³ Alternatively, it should be noted that Adachi may also be removed as a reference by perfecting Applicants' foreign priority pursuant to 37 CFR § 1.55(a)(4).

⁴ The subject matter of Adachi is owned by Nippon Shokubai Co., Ltd., as evidenced by the assignment recorded on reel/frame: 015741/0892. Applicants' claimed invention is also owned by Nippon Shokubai Co., Ltd., as evidenced by the assignment recorded on reel/frame: 017673/0709.

weight % saline is “not less than 31 g/g.”⁵ In fact, Nakashima teaches that “[t]he CRC is *more favorably* not less than 32 g/g, *still more favorably* not less than 33 g/g, *yet still more favorably* not less than 34 g/g, *particularly favorably* not less than 35 g/g, *more particularly favorably* not less than 36 g/g.”⁶ Thus, Nakashima actually *teaches away* from the CRCs value of independent claim 3.

In the Office Action of March 17, 2009, the Examiner asserts that Nakashima teaches a water-absorbing agent with “a CRC of not less than 25.8 g/g.”⁷ However, it should be noted that the “25.8 g/g” value *merely* pertains to particles 13d, which (along with particles 13a-13c) are only constituents of the *overall* water-absorbing agent 13.⁸ As evidenced by Table 2 of Nakashima, the *overall* water-absorbing agent 13 has a CRC of “31.7” g/g (which clearly does not read on the “**less than 29 g/g**” language of independent claim 3). Table 2 of Nakashima has been reproduced below for convenience of reference.

⁵ Nakashima: p. 7, ln. 19-20; p. 8, ln. 17-18; p. 9, ln. 15-16; p. 44, ln. 3-5; p. 46, ln. 16-17; p. 52, ln. 15-16; p. 53, ln. 12-13; p. 54, ln. 10-11.

⁶ Nakashima: p. 44, ln. 11-14.

⁷ Office Action (03/17/2009): p. 11, ln. 2-3.

⁸ Nakashima: p. 73, ln. 17 – p. 74, ln. 3; p. 87, Table 2, Example 13.

Nakashima

Table 2

	Water-absorbing agent as measured	Absorption capacity without load (g/g)	Absorption capacity under a load (g/g)	Saline flow conductivity (SFC) ($10^{-3} \times \text{cm}^3 \times \text{s}$ $\times \text{g}^{-1}$)	Particle diameter distribution (weight %)
Example 13	(13-a)	33.2	26.5	35	21
	(13-b)	32.8	26.7	37	22
	(13-c)	30.8	26.4	39	33
	(13-d)	25.8	23.9	47	17
	Water-absorbing agent (13)	31.7	25.8	42	95
Example 14	(14-a)	34.0	25.9	18	22
	(14-b)	34.3	26.7	21	23
	(14-c)	32.3	26.4	24	32
	(14-d)	26.5	23.7	26	18
	Water-absorbing agent (14)	33.1	24.2	20	95
Comparative Example 10	(10-a)	33.9	26.5	18	21
	(10-b)	33.7	26.9	29	23
	(10-c)	31.9	26.8	36	34
	(10-d)	26.6	24.0	38	18
	Comparative water-absorbing agent (10)	31.9	25.8	30	96
Comparative Example 11	(11-a)	31.5	23.5	15	24
	(11-b)	31.4	23.3	20	28
	(11-c)	30.1	23.2	18	33
	(11-d)	26.5	20.9	9	12
	Comparative water-absorbing agent (11)	30.1	22.2	11	97
Comparative Example 12	(12-a)	29.9	22.7	18	14
	(12-b)	30.6	23.8	15	26
	(12-c)	29.9	23.2	10	38
	(12-d)	26.7	22.5	9	20
	Comparative water-absorbing agent (12)	29.7	21.4	6	98
Example 15	(15-a)	-	-	-	-
	(15-b)	35.3	26.9	21	35
	(15-c)	34.6	26.8	20	65
	(15-d)	-	-	-	-
	Water-absorbing agent (15)	35.0	26.9	20	100
Example 16	(16-a)	-	-	-	-
	(16-b)	32.5	26.2	35	32
	(16-c)	31.9	26.3	51	68
	(16-d)	-	-	-	-
	Water-absorbing agent (16)	32.1	26.3	50	100

In reply, the Examiner asserts in the Office Action of October 28, 2009 that a CRC of "not less than 31 g/g" is just one embodiment and that "Nakashima does not discredit the ranges below 31 g/g," thereby concluding that "Nakashima does not teach away from the claimed invention."⁹ Applicants respectfully disagree.

⁹ Office Action (10/28/2009): p. 7, section 29.

Contrary to the Examiner's belief, **Nakashima does criticize a CRC of "less than 31 g/g."**¹⁰ For instance, Nakashima explicitly teaches that when the CRC is "not less than 31 g/g" ("*more particularly favorably not less than 36 g/g*"), a "compact" sanitary material having "excellent" absorption may be achieved while "lowering the cost."¹¹ In contrast, when the CRC is "less than 31 g/g," the absorption is "small," thereby increasing the likelihood that a previously-absorbed fluid (e.g., urine) will return to the surface of the sanitary material.¹² Furthermore, to obtain the desired absorption, more water-absorbing agents must be used, thereby making the sanitary material "bulky and heavy" while also "raising the cost."¹³ Thus, it would be clear to one ordinarily skilled in the art that Nakashima discourages a CRC of "less than 31 g/g." The pertinent teaching from p. 44 of Nakashima has been reproduced below for convenience of reference.

¹⁰ Nakashima: p. 44, ln. 14-23.

¹¹ Nakashima: p. 44, ln. 3-14.

¹² Nakashima: p. 44, ln. 14-18.

¹³ Nakashima: p. 44, ln. 19-23.

Nakashima (p. 44, ln. 2-23)

(b) CRC:

The water-absorbing agent, according to the present invention, favorably exhibits a 30 minutes' absorption capacity of not less than 31 g/g without load for a 0.90 weight % physiological saline (Centrifuge Retention Capacity/CRC). Because the CRC becomes not less than 31 g/g, the absorption of the sanitary material comprising the water-absorbing agent is excellent, and the compact sanitary material can be realized, and further it also results in lowering the cost of a water-absorbent structure (incidentally, the water-absorbent structure means a water-absorbent structure for body fluids, comprising the water-absorbing agent, and if necessary, other water-absorbent materials such as fibers). The CRC is more favorably not less than 32 g/g, still more favorably not less than 33 g/g, yet still more favorably not less than 34 g/g, particularly favorably not less than 35 g/g, more particularly favorably not less than 36 g/g. In the case where the 30 minutes' absorption capacity without load for a 0.90 weight % physiological saline is less than 31 g/g, the total amount of urine that can be absorbed by the water-absorbent structure is small, and the amount of the urine as is once absorbed by the water-absorbent structure and then returns to the surface of the disposable diaper is greatly increased. Furthermore, when the absorption amount of the urine as demanded to the water-absorbent structure is designed to be maintained, there are disadvantages in that: the amount of the water-absorbing agent as used for the water-absorbent structure is increased, the sanitary material becomes bulky and heavy, and it results in raising the cost of the water-absorbent structure.

**Teaching
away
from
claimed
invention**

In sum, Nakashima clearly teaches away from the claimed invention. Applicants respectfully submit that the Examiner's contrary interpretation of Nakashima is merely the result of impermissible hindsight based on information gleaned from Applicants' own disclosure as opposed to the prior art.

For at least the reasons above, a *prima facie* case of obviousness cannot be established with regard to claim 3. Consequently, a *prima facie* case of obviousness cannot be established with regard to claims 4 and 20-23, at least by virtue of their

dependency from claim 3. Accordingly, Applicants respectfully request the Examiner to reconsider and withdraw the above rejection.

CONCLUSION

In view of the above, Applicants respectfully request the allowance of all the pending claims in the present application.

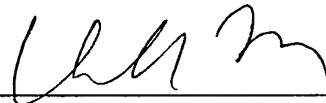
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Alex C. Chang, Reg. No. 52,716, at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. §1.17; particularly, extension of time fees.

Respectfully submitted,

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